

REMARKS

Claims 1-3, 6-10, 12-13, 15-17, 19-20, 22-24, 27-30, 32-34, 38-42, 44-46, and 48-54 are now pending in the application, of which Claims 8-9, 13, 20, 23, 42, and 48 are withdrawn from consideration. Claims 1-3, 6-7, 10, 12, 15-17, 19, 22, 24, 27-30, 32-34, 38-41, 44-46, and 49-54 stand rejected. Claims 1, 2, 3, 10, 16, 17, 24, 49, 50, 51, 52, 53, and 54 have been amended. Support for the amendments can be found throughout the application, drawings and claims as originally filed and, as such, no new matter has been presented. The Examiner is respectfully requested to reconsider and withdraw the rejections in view of the amendments and remarks contained herein.

REJECTION UNDER 35 U.S.C. § 112

Claims 1-3, 6, 7, 10, 12, 15-17, 19, 22, 24, 27-30, 32-34, 38-41, 44-46, and 49-54 stands rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. The Office particularly objects to the term "flat" when used with respect to a countersink, citing that a countersink is conical. The Office's attention is directed to Claims 1, 2, 3, 10, 16, 17, 24, 49, 50, 51, 52 and 53 which have been amended as to include the limitations that the bore or aperture defined through the body has a bore axis and the countersink surface has a cross-section parallel to the throughbore axis that defines a flat surface. Applicants believe that this clarifies that the cross-section of the countersink that is parallel to the bore axis is flat as opposed to the countersink itself.

Claims 24, 49 and 54 stand rejected under 35 U.S.C. §112. The Office states that it is unclear what is intended by the outer diameter of the conical surface. Applicants respectfully submit that the outer diameter and inner diameter are with

respect to a bore centerline, however, Applicants have amended Claims 24, 49, and 54 to overcome this rejection. Therefore, reconsideration and withdrawal of the rejections under 35 U.S.C. § 112 are respectfully requested.

REJECTION UNDER 35 U.S.C. § 103

Claims 1-3, 6-7, 10, 12, 15-17, 19, 22, 24, 27-30, 32-34, 38-41, 44-46, and 49-54 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Hutter, III et al. (U.S. Pat. No. 5,704,747) in view of Peterson (U.S. Pat. No. 5,096,350). This rejection is respectfully traversed.

Initially, Applicants note that Hutter discloses a floating nut element 18 surrounded by a closed dome 20 (see at least column 3, lines 31-35). As illustrated in Figure 1 of Hutter, the dome 20 is not disposed around a substantial portion of the base, as also noted by the Examiner. Hutter further does not disclose a member defining a first opening on a first surface and a second opening on a second surface as claimed. Rather, the dome 20 is positioned such that the nut 18 can float within the dome 20. The dome 20 further has a "radially outwardly extending rim 22 for adhesive mounting onto [a] blind side of the substrate 12" (see at least Column 3, lines 33-36). Hutter discloses that it is an object of his invention to "provide a structure and method for installing a protective liner sleeve without requiring separate riveted connection, and in a manner which permits the nutplate assembly to be adhesively mounted securely and firmly to the substrate," a purpose accomplished by the dome 20 (emphasis added, see at least Column 1, lines 59-64). Peterson teaches a body 20 having a non-constant thickness disposed against a shim 50 in combination with a cage 30 to restrict a

movement of the body 20 (see at least Col. 3, lines 3-18). The body 20 of Peterson does not have a bore including flat countersink surface as claimed, rather the bore in the body 20 of Peterson has a curved radius, best shown in Figure 3. The cage 30 of Peterson is secured to the supporting structure by welding.

In contrast, Applicants note independent Claims 1 and 2 include a throughbore or bore including a flat countersink surface that corresponds with the transition portion, and Claim 3 includes "the base including a flat countersink surface," which corresponds to the transition portion. Applicants further note Claims 10 and 16 include the bore including a flat countersink surface aligned with and spanning the transition portion. Claims 10, 16, 17 and 24 each include the bore including a flat countersink surface that corresponds to the transition portion. Additionally, Claim 24 further includes that the flat countersink surface is formed to correspond with the transition portion. Claim 24 also includes "the flat countersink surface having a first countersink diameter opposite the body, which is greater than the first diameter." Claim 49 includes "the base having a base minimum thickness, and the transition portion having a transition minimum thickness greater than the base minimum thickness, said transition portion defining a flat conical surface," "the flat conical surface having a first conical diameter opposite the body which is greater than the first diameter.

Additionally, Claim 50 includes "the body having a constant body minimum thickness, and the transition portion having a transition minimum thickness greater than the body minimum thickness, said transition portion defining a flat surface. Applicants further note that Claim 51 includes the "transition portion having a generally conical bore coaxial with the bore of the body," and "the minimum thickness of the transition portion

[being] greater than the minimum thickness of the base,” and Claim 52 includes “said bore defining a flat conical surface at the transition portion.” Claim 53 includes “said threaded bore having a second radius and countersink having a first countersink diameter adjacent to the base smaller than or equal to the first diameter,” and “the base having a constant base minimum thickness...the body having a body minimum thickness, the transition portion having a transition minimum thickness greater than the body minimum thickness and the base minimum thickness.

Applicants respectfully submit that at least these features as claimed are not taught by either Hutter or Peterson, alone or in combination. In this regard, Applicants note that Hutter and Peterson fail to teach, suggest or disclose a countersink surface having a cross-section parallel to a bore axis that defines a flat surface as claimed in Claims 1-3, 10, 16, 17, 24, and 49-54. The Office notes that Hutter appears to show a countersink shape, however, Applicants note that Hutter does not disclose a bore with a flat countersink that **corresponds to or is aligned with the transition portion**. Rather, the countersink extends for a portion of a transition portion, and a threaded portion extends for the remainder of the transition portion. Applicants note that Peterson does not remedy this shortcoming of Hutter as Peterson discloses the curved radius spanning a mere portion of the transition portion.

Further, with regard to Claims 24 and 49, Applicants respectfully assert that Hutter and Peterson do not teach, suggest or disclose a flat countersink surface having a first countersink diameter **opposite the base** or a flat conical surface having a first conical diameter **opposite the base**, which is greater than or equal to a first diameter of the body. Rather, with regard to Hutter, as shown in Figures 1 and 7, the diameter of

the countersink is smaller than the diameter of the floating nut element 18. With reference to Figure 3 of Peterson, the diameter of the curved radius is smaller than a diameter of the body 20. Accordingly, Applicants further submit neither Hutter nor Peterson teach at least these features of Claims 24 and 49.

In addition, Applicants respectfully submit that there are secondary considerations that make the subject of Claims 1-3, 10, 16, 17, 24, and 49-54 patentable in light of Hutter and Peterson. In this regard, Applicants note that secondary considerations are also essential components of the obviousness determination. See *In re Emert*, 124 F.3d 1458, 1462, 44 USPQ 2d 1149, 1153 (Fed. Cir. 1997) Specifically:

This objective evidence of nonobviousness includes copying, long felt but unsolved need, failure of others, see *Graham v. John Deere Co.*, 383 U.S. 1, 17 18, 15 L. Ed. 2d 545, 86 S. Ct. 684 (1966), **commercial success**, see *In re Huang*, 100 F.3d 135, 139 40, 40 USPQ 2d 1685, 1689 90 (Fed. Cir. 1996)... (emphasis added). See *In re Rouffet*, 47 USPQ 2d 1453, 1456 (Fed. Cir. 1998).

With regard to commercial success, Applicants note that sales figures alone are evidence of commercial success. *Tec Air, Inc. v. Denso Mfg. Mich. Inc.*, 52 USPQ 2d 1294, 1299 (Fed. Cir. 1999). Emhart, the assignee of the subject matter claimed in Claims 1-3, 10, 16, 17, 24, and 49-54, has now sold approximately 1.65 million fasteners for spanning a large gap to Ford Motor Company. Emhart expects to sell approximately 2.3 million fasteners for spanning a large gap to Ford Motor Company over the next year. Each of the Emhart fasteners for spanning a large gap sold to Ford Motor Company employs the features recited in pending Claims 1-3, 10, 16, 17, 24, and

49-54. Each of the Emhart fasteners for spanning a large gap sold to Ford Motor Company is sold at a price premium over competitive products.

Accordingly, in view of the above discussion, as Hutter and Peterson, either alone or in combination, do not teach, suggest or disclose each and every feature of Claims 1-3, 10, 16, 17, 24, and 49-54, Applicants respectfully request the Examiner to reconsider and withdraw the rejection of Claims 1-3, 10, 16, 17, 24, and 49-54 under 35 U.S.C. § 103(a).

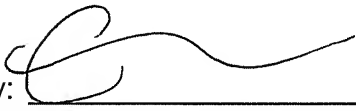
With regard to Claims 6, 7, 12, 15, 19, 22, 27-30, and 32-34, Applicants note these claims depend directly or indirectly from either independent Claims 1, 2, 3, 10, 16, 17, or 24, and thus, should be in condition for allowance for the reasons set forth for Claims 1, 2, 3, 10, 16, 17, or 24 above. Accordingly, Applicants respectfully requests the Examiner reconsider and withdraw the rejections of Claims 6, 7, 12, 15, 19, 22, 27-30, and 32-34 under 35 U.S.C. § 103(a).

CONCLUSION

It is believed that all of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider and withdraw all presently outstanding rejections. It is believed that a full and complete response has been made to the outstanding Office Action, and as such, the present application is in condition for allowance. Thus, prompt and favorable consideration of this amendment is respectfully requested. If the Examiner believes that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at (248) 641-1600.

Respectfully submitted,

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